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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 08/479,999   | 06/28/1994  | CHRISTINE L. BRAKEL  | ENZ-47(C)           | 8801             |
| 28171  | 7590        | 12/27/2005           | EXAMINER            |                  |
| ENZO BIOCHEM, INC.<br>527 MADISON AVENUE (9TH FLOOR)<br>NEW YORK, NY 10022 |             |                      | ZHOU, SHUBO         |                  |
|  |             | ART UNIT             |                     | PAPER NUMBER     |
|  |             |                      |                     | 1631             |

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|  |                  |               |
|--|------------------|---------------|
| <b>Advisory Action</b><br><b>After the Filing of an Appeal Brief</b> | Application No.  | Applicant(s)  |
|  | 08/479,999       | BRAKEL ET AL. |
|  | Examiner         | Art Unit      |
|  | Shubo (Joe) Zhou | 1631          |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The reply filed 19 July 2004 is acknowledged.

1.  The reply filed on or after the date of filing of an appeal brief, but prior to a final decision by the Board of Patent Appeals and Interferences, will not be entered because:

- a.  The amendment is not limited to canceling claims (where the cancellation does not affect the scope of any other pending claims) or rewriting dependent claims into independent form (no limitation of a dependent claim can be excluded in rewriting that claim). See 37 CFR 41.33(b) and (c).
- b.  The affidavit or other evidence is not timely filed before the filing of an appeal brief. See 37 CFR 41.33(d)(2).

2.  The reply is not entered because it was not filed within the two month time period set forth in 37 CFR 41.39(b), 41.50(a)(2), or 41.50(b) (whichever is appropriate). Extensions of time under 37 CFR 1.136(a) are not available.

Note: This paragraph is for a reply filed in response to one of the following: (a) an examiner's answer that includes a new ground of rejection (37 CFR 41.39(a)(2)); (b) a supplemental examiner's answer written in response to a remand by the Board of Patent Appeals and Interferences for further consideration of rejection (37 CFR 41.50(a)(2)); or (c) a Board of Patent Appeals and Interferences decision that includes a new ground of rejection (37 CFR 41.50(b)).

3.  The reply is entered. An explanation of the status of the claims after entry is below or attached.

4.  Other:

The rejection of claims 1-19, 21-39, 41, 51, and 52 under 35 USC 112, first paragraph, set forth in the final rejection stands. The amendment filed 7/19/04, if entered, would not overcome the rejection because the new matter introduced to the claims in the amendment filed 11/19/99 as set forth in the final rejection mailed 9/26/00, such as (N)xM(N)yM in claim 1, remains in the amended claims.

The rejection of claims 1-2, 4, 8, 12-14, 19, and 42-50 under 35 USC 102(b) as being anticipated by Miller et al. set forth in the final rejection stands. The amendment filed 7/19/04 would not overcome the rejection because the added "wherein" clause ("wherein the compound acts as an RNase H substrate when complexed with a complementary RNA") would be an inherent property of the claimed compound and that of the compound disclosed by Miller et al. In *In re Best* (195 USPQ 430) and *In re Fitzgerald* (205 USPQ 594), the court discussed the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation, the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph). In the instant case, the product disclosed by Miller et al. is the same as that claimed in the application and it would act as an RNase H substrate when complexed with a complementary RNA.

As set forth in the Advisory action mailed 10/14/05, the rejection of claims 1-4, 12-14, 42-50 under 35 USC 102(b) as being anticipated by Stein et al., and the rejection of claims 1-52 under 35 USC 103(a) have been withdrawn.

Claims 20 and 40 are allowable.

*Ardin H. Marschel 12/20/05*  
 ARDIN H. MARSHEL  
 SUPERVISORY PATENT EXAMINER

